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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,103	11/17/2003	Masao Takagi	032099	9771

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EXAMINER

ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,103

Applicant(s)

TAKAGI ET AL.

Examiner

John J. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

SECOND OFFICE ACTION

Amendments

1. This Second Office Action is in response to the Amendment Under 37 C.F.R. 1.111 received June 24, 2005. Claims 1-8 are pending in this application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhou (U.S. Patent Publication 2002/0146259 A1).
4. Zhou discloses nickel endless belts made by electroforming wherein the crystal orientation ratio $I_{(200)}/I_{(111)}$ is 3 or more (e.g. see claim 1) and a release layer with an elastic layer there between is formed on the belt (e.g. see claim 9). Regarding the pending independent

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claims reciting a crystal orientation ratio $I_{(200)}/I_{(111)}$ of "more than 80", Zhou shows an example of a crystal orientation ratio $I_{(200)}/I_{(111)}$ of "80" (e.g. Example 2 in Table 2) and this value approximates the value of "more than 80". Applicant has not shown a patentable distinction between a value of "80" and the closely approximated value of "more than 80". Specific claimed alloy, whose compositions are in such close proportions to those in prior art that, *prima facie* one skilled in the art would have expected them to have the same properties, must be considered to have been obvious from known alloys, *Titanium Metals Corporation of America v. Banner*, 227 USPQ 773. In any event, Zhou's disclosure requiring a crystal orientation ratio of $I_{(200)}/I_{(111)}$ is 3 or more clearly includes the claimed range of "more than 80" and also "100 or more". Example 2 in Table 2 which shows a belt with crystal orientation ratio $I_{(200)}/I_{(111)}$ of 80 is clear evidence that Zhou considers crystal ratios much higher than the lower limit of 3 to also be his invention. Also in evidence is the showing in Table 2 that higher durability time appears to correspond higher crystal ratio examples. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the crystal ratio range disclosed by Zhou because overlapping ranges have been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549.

Response to Argument/Allowable Subject Matter

5. Applicant's arguments filed June 24, 2005 have been fully considered but they are not persuasive.

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6. Regarding issue that the pending independent claims now recite a crystal orientation ratio $I_{(200)}/I_{(111)}$ of "more than 80", it is noted that Zhou shows an example of a crystal orientation ratio $I_{(200)}/I_{(111)}$ of "80" (e.g. Example 2 in Table 2) and this value clearly approximates the value of "more than 80". Applicant has not shown a patentable distinction between a value of "80" and the closely approximated value of "more than 80". Specific claimed alloy, whose compositions are in such close proportions to those in prior art that, prima facie one skilled in the art would have expected them to have the same properties, must be considered to have been obvious from known alloys, *Titanium Metals Corporation of America v. Banner*, 227 USPQ 773. In any event, Zhou's disclosure requiring a crystal orientation ratio of $I_{(200)}/I_{(111)}$ is 3 or more clearly includes the claimed range of "more than 80" and also "100 or more". On this issue, applicant argues that the currently claimed crystal orientation ratio $I_{(200)}/I_{(111)}$ of "more than 80" and "100 or more" provides "unexpected results". A review of applicant's disclosure, however, shows factual data for improved results only beginning at crystal orientation ratio $I_{(200)}/I_{(111)}$ of 113 or more (e.g. see Table 1 and Figures 3-5). Therefore, applicant's arguments and claims are not commensurate with the factual data provided by the applicant's disclosure since there is no actual data showing unexpected results commensurate with the ratio ranges of "more than 80" or "100 or more". It is noted, however, that since there is sufficient factual data showing unexpectedly improved results for crystal ratios beginning at "113", claims requiring a crystal orientation ratio $I_{(200)}/I_{(111)}$ of not less than "113 and not more than 250" would be allowable in view of the data in applicant's disclosure.

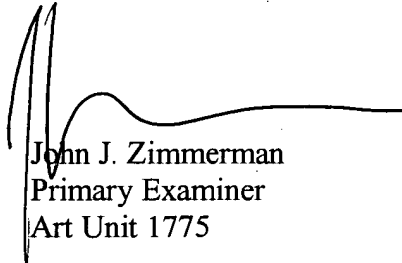
Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Zimmerman
Primary Examiner
Art Unit 1775

jjz
July 27, 2005